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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,433	09/07/2000	Kip Van Steenburg	7175/65430	6205

7590 12/26/2001

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EXAMINER
TRETTEL, MICHAEL

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 12/26/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/660,433	Applicant(s) STEENBURG, KIP VAN	
	Examiner Michael Trettel	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-100* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Reissue Applications

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The declaration must state whether the inventor is a sole or joint inventor of the invention as required by 37 CFR 1.63(a)(4).

The declaration is not specific at to what error is being relied upon as a basis for the reissue under 37 CFR 1.175(a)(1). In particular, the applicant has identified one error in claim 1 as being the basis for the reissue. However, the specific changes or amendments to the claims have not been identified nor is their any discussion as to how these changes correct the error. In the present application new claims 14 to 100 have been presented, their difference from the original claims must be identified along with a statement identifying how these differences or changes correct the alleged error(s).

The declaration must state that "*all errors being corrected in the reissue application up to the time of filing of the oath or declaration arose without any deceptive intention on the part of the applicant*" as required by 37 CFR 1.175(a)(2) or the equivalent.

Claims 1 to 100 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 14 to 100 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The applicant is attempting to claim the supporting device without reference to a longitudinal axis and a clamping device having an axis transverse to the longitudinal axis. The applicant is also attempting to drop out any reference to a clamping device that can simultaneously clamp and release the supporting device relative to the clamping device about the first and second (longitudinal and transverse) axes. These limitations were expressly added during the prosecution of the 08/813708 application in order to define over the subject matter

disclosed in the Klevstad patent. These inclusion of these limitations in the original claims 1 to 13 were also relied upon by the applicant as part of the arguments used to secure an allowance over the Klevstad patent. Reference should be made to the arguments and statements made on pages 3 to 5 of the amendment of February 17, 1998 (Paper No. 4) of the 08/813,708 application. Taking as an example claim 1 as amended in the 08/813,708 application, and newly filed claim 14, the differences are as follows:

Claim 14 drops out the reference to the abduction dimension and lithotomy dimension made in lines 2 and 3 of old claim 1:

Claim 14 drops out the limitation of "having a longitudinal axis" in line 4 of old claim 1 which had been added by amendment:

Claim 14 drops out the limitation "transverse to said longitudinal axis" added to line 8 of claim 1, and drops out any reference to the mounting device having a first axis:

Claim 14 drops out "simultaneously" added to line 9 of claim 1:

Claim 14 drops out the added limitation concerning to the support device being fixed in the clamping device against rotation about said longitudinal axis added to lines 11 to 13 of old claim 1, and now states that the support device is clamped against movement about the second plurality of axes;

Claim 14 drops out the limitations added to lines 14 and 15 of claim1 stating that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, and now states that the clamping device can selectively clamp and release the support device relative to the mounting device.

New claim 14 therefore removes or broadens almost all the limitations added to old claim 1 during the prosecution in order to define over the Klevstad reference, these limitations were referred to and relied upon extensively in the applicant's arguments as defining over the Klevstad patent. Since these limitations were added in order to secure an allowance, any attempt to now drop them out altogether is an attempt at recapture. This is supported by the applicant's declaration, in which it is stated clearly that the mistake sought for correction was limiting claim 1 to a supporting device with a longitudinal axis and the clamping device having an axis transverse to the longitudinal axis. These limitations were added during the prosecution of claim 1 in the original application, and were not present in the claims as originally filed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Navarro et al (5,918,330 and 6,058534), Cameron et al, Keselman et al (5,582,379), Keselman (5,560,577), Hopper et al, Akcelrod, and Klevstad show adjustable leg supports which are of particular interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Trettel whose telephone number is 703-308-0416. The examiner can normally be reached on Monday, Tuesday, Thursday, or Friday from 7.30 am to 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.

Michael Trettel
Primary Examiner
Art Unit 3628